

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Andrew T. Wilson

Serial No.: 10/684,167

Examiner: Jeffrey Donels

Filed: October 10, 2003

Group Art Unit: 2837

For: PORTABLE HAND-HELD MUSIC SYNTHESIZER AND
NETWORKING METHOD AND APPARATUS

Confirmation No.: 2311

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REPLY BRIEF

This Reply Brief is responsive to the Examiner's Answer mailed September 25, 2007.

Claims 11-15 and 27-30 are rejected under 35 U.S.C. §103(a) as being obvious over Ito in view of Sitrick.

Claims 11 and 27

The Legal Basis for the Rejection is Incorrect

The **Response to Argument** section of the Examiner's Answer continues to apply the *per se* rule that "mere duplication of working parts does not constitute nonobviousness". See, Answer, page 5, end of first full paragraph; page 6, end of first partial paragraph. However, as

argued in the Appeal Brief, *In re Ochiai* held that such *per se* rules of obviousness are legally incorrect. See, *In re Ochiai*, 37 USPQ2d 1127, 1133 (CAFC 1995). Significantly, the Examiner's Answer does not address this case. The holding of *In re Ochiai* is entirely consistent with *KSR v. Teleflex* in which the Supreme Court cautioned against the use of rigid and mandatory formulas. See, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1398 (U.S. 2007).

Instead, the question of obviousness requires an expansive and flexible approach. See, *Id.* at 1395. As stated by the Court in *Ochiai*, section 103 requires a fact-intensive comparison of the claimed invention with the teachings of the prior art. See, *In re Ochiai*, 37 USPQ2d at 1132. Such an analysis was set forth in the Appeal Brief, and select factual points are addressed in the next section below.

The Examiner cites *In re McLaughlin*, 170 USPQ 209 (CCPA 1971) for the proposition that any judgment on obviousness is in essence necessarily a reconstruction based upon hindsight reasoning. However, even the *McLaughlin* case cautions that such a reconstruction is permissible "so long as it takes into account *only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure*". *Id.* at 212 (emphasis added). The analysis set forth in the **Response to Argument** section of the Examiner's Answer runs afoul of the emphasized portion of the quote as addressed in the next section below.

The Factual Analysis Underlying the Rejection is Incorrect

Claims 11 and 27 both recite plural apparatus arranged to communicate with each other, each including an audio score *synthesis* mechanism, e.g., a musical instrument or other synthesis mechanism. See, Specification, page 7, lines 22-27. In the **Response to Argument**, the Examiner states that it was known by one of ordinary skill in the art that in a group of such devices or *musical instruments* the ability to switch from a master to a slave was desirable, and further states that Sitrick demonstrates that it was both a known problem and a solution was taught in the prior art. See, Answer, bottom of page 5.

This is an incorrect interpretation of Sitrick. Sitrick does not teach, as the Examiner suggests, networked devices including instruments or other synthesis mechanisms wherein the devices can switch from master to slave. Instead, Sitrick is essentially a system for replacing

sheet music with electronically distributed and edited musical compositions in a paperless environment (column 3, lines 10-20). Although Sitrick's system includes the ability to capture performances (column 2, line 45) and combine them (column 2, line 49), for imperceptibly delayed play-back, Sitrick does not disclose any synthesis devices (e.g., instruments) integrated into the networked devices. That is, Sitrick contemplates instruments that are separate from the networked devices. Sitrick discloses networked workstations that can act as master or master/slave (column 16, lines 65-66), but these workstations only display musical compositions and record and play performances—they do not include synthesis mechanisms. Thus the "problem" and solution which the Examiner alleges were known in the art were not actually taught by the prior art. Instead, they were gleaned from Applicant's disclosure.

Claims 11 and 27 both recite plural apparatus arranged to communicate with each other, each including an audio score *synthesis* mechanism, e.g., a musical instrument or other synthesis mechanism. Moreover, including a mixing mechanism in *each* of the musical apparatus makes possible a real-time peer-to-peer musical jam session, a real-time peer-to-peer 'swarm,' or an ad-hoc musical jam session. See, Specification, page 6, lines 19-20 and page 7, lines 10-12. Neither Ito nor Sitrick disclose all of the recited features of claims 11 and 27, nor do they provide any reason to combine the references to achieve the claimed inventions.

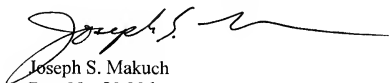
Conclusion

Applicant requests that the rejection of claims 11-15 and 27-30 be reversed.

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Respectfully submitted,

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